



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Patent Application of:

Hsieh Sheng-Bin

Serial No.: 10/633,858

Filed: August 4, 2003

Title: SOFT STORAGE BIN

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Group Art Unit: 3727

Examiner: Joseph C. Merek

**Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the final rejections of the Examiner in the Final Office Action mailed on March 15, 2005. No amendments are being filed with this Request. This Request is being filed with a Notice of Appeal. This review is requested in view of the remarks that follow.

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I hereby certify that this correspondence is being deposited with the United States Postal Service as EXPRESS MAIL in an envelope addressed to: MAIL STOP AF, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on September 15, 2005.

Name: Chris Wipper

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Signature

9/15/05
Date 9/15/05

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REMARKS FOR REQUEST FOR REVIEW

Claims 1-4, 6-8, and 10-22 are pending. A final Office Action was mailed on March 15, 2005. An amendment to claims 1 and 19 was submitted in a response to the final Office Action filed on July 14, 2005. An Advisory Action was mailed on July 26, 2005 indicating that the amendment would not be entered.

The pending claims are directed to a soft storage bin having a novel and non-obvious structure. In certain embodiments, the bin comprises a body of flaccid material forming a closed bottom, two first sidewalls, and two second sidewalls. A hard full-wall board is embedded in at least one of the two first sidewalls. Two hard half-wall boards are embedded in each of the second sidewalls, the half-wall boards being separated by a folding-seam. A hard bottom board is removably seated within the bin, having a surface entirely abutting the bottom and being uniformly supported by the bottom.

These features of the bin allow it to be easily and repeatedly collapsed in a highly durable manner along these folding-seams when the bottom board is removed from the interior of the bin. The bin can always be easily re-erected after it is collapsed by simply seating the bottom board once again upon the closed bottom of the bin. No folding or bending is required of any of the wall boards embedded in the sidewalls.

Claims 1-4, 6-8, and 10-22 were rejected as being unpatentable under 35 U.S.C. §103(a) over Bauernfreund et al (U.S. Patent No. 2,485,028) in view of Wang et al (U.S. Patent No. 6,149,025). Claims 1-4, 6-8, and 10-22 were also rejected as being unpatentable under 35 U.S.C. §103(a) over Bauernfreund in view of Wang and further in view of Nickell et al (U.S. Patent No. 6,244,443).

Independent claim 1 is directed to a soft storage bin having a body forming a closed bottom where the bottom is bound to each of the bin's two first sidewalls and two second sidewalls along a bottom edge. The Examiner acknowledges that this feature is missing from Bauernfreund. The Examiner fails, however, to make the necessary showing of reasons or motivation within Bauernfreund and Wang that supports the combination and modification relied

upon by him in rejecting the claim under §103(a).

The Examiner makes reference in the final Office Action mailed on March 15, 2005, to how it “would have been obvious to employ the closed bottom of Wang in the container of Bauernfreund et al to prevent the board 10 from falling out of the container and to provide a stronger container.” This statement is not a showing of a motivation within the teachings of these references that arrives at Applicant’s claimed invention or sets forth a specific explanation as to how a skilled artisan can extrapolate the invention from suggestions in either Bauernfreund or Wang. (See Applicant’s further remarks in the Response to Final Office Action filed on July 14, 2005 (Response of 7/14/2005) at pages 8-9). Both of these references also specifically teach against the modification suggested by the Examiner. The teachings of the references are not sufficient to render the claim *prima facie* obvious since the combination proposed by the Examiner changes the principle of operation of the devices being modified. (See further remarks in Response of 7/14/2005 at pages 9-10).

Claim 1 also requires at least one second sidewall to have a substantially vertical folding-seam forming two half-wall pockets, each half-wall pocket receiving one hard half-wall board embedded therein, and abutting one full-wall pocket along a vertical edge. This limitation is missing from each of the references cited by the Examiner in the final Office Action. The box in Bauernfreund teaches sidewalls that have full-wall boards creased transversely near their center to define integral segments, not separate half-wall boards. (See further remarks in Response of 7/14/2005 at page 10). Wang teaches diagonal folding lines and discloses no sidewall having two embedded hard half-wall boards. The bulk bag in Nickell also does not disclose any of its eight identical sidewall portions having two half-wall boards, much less even one such portion having such boards separated by a folding-seam. (See further remarks in Response of 7/14/2005 at pages 11-12).

The Examiner states in the final Office Action that while the specification in Bauernfreund may not teach a sidewall having two half-boards separated by a folding-seam, this feature is shown in Fig.7 of the reference and that such “accidental disclosure” can be relied upon as a teaching of the limitation in question. Applicant submits that Fig. 7 is at the very least

ambiguous and does not clearly show and is not intended to clearly show the claimed limitation. The drawing is rather an attempt to depict the construction more clearly set forth in the specification. Moreover, the legal authorities cited by the Examiner in the Office Action are not applicable to the position taken by him in support of his reliance upon Bauernfreund. In particular, none of the cases cited in the final Office Action stand for the proposition that a teaching can be drawn from a drawing in a reference when such supposed disclosure is in conflict with specific assertions made in the specification itself regarding the structure shown in that drawing. (See further remarks in Response of 7/14/2005 at page 11).

Even if arguably Bauernfreund, Wang and Nickell should teach together each of the elements in claim 1, there is no motivation shown by the Examiner for combining these references. He states in the final Office Action that it "would have been obvious to employ the separate pockets of Nickell et al in the container of Bauernfreund et al to provide a more flexible joint to make the container easier to collapse." There are no reasons or teachings within any of the references to support this assertion. This is not the required showing of obviousness under §103(a) but rather an exercise in hindsight since there must be more of a justification for combining pieces of prior art than solely the fact that they were known at the time of the invention. The fact that references can be combined does not render the resulting modification obvious unless these references suggest the desirability of such a combination. MPEP §2143.01.

For all of these reasons, a prima facie case of obviousness has not been established by the Examiner to maintain a rejection of independent claim 1. Applicant believes that this rejection should therefore be withdrawn and that it and claims 2-4, 6-8, and 10-12 that depend from it be allowed.

Independent claim 13 was also rejected as being unpatentable under §103(a) over Bauernfreund in view of Wang and over Bauernfreund in view of Wang and further in view of Nickell. Claim 13 includes the limitation in claim 1 that the soft storage bin have a body forming a closed bottom. The claim also requires that both second sidewalls have two hard half-wall boards embedded in each, the two boards being separated from one another by a folding-seam in the body of the bin. For all of the reasons given above with respect to the allowance of claim 1, a

prima facie case of obviousness has not been established by the Examiner to maintain a rejection of this claim. Applicant believes that this rejection has been shown to be traversed and that claim 13 and claims 14-18 that depend from it should be allowed.

Independent claim 19 was rejected in the final Office Action as also being unpatentable under §103(a) over Bauernfreund in view of Wang and over Bauernfreund in view of Wang and further in view of Nickell. Claim 19 includes the limitations that the soft storage bin have a body forming a closed bottom and that two sets of two hard half-wall boards be respectively embedded in the two second sidewalls, the two boards of each set being separated from one another by a vertical folding-seam in the body of the bin. For all of the reasons given above with respect to the traversal of the rejection of claim 1, Applicant believes that this rejection shown be withdrawn and that claim 19 as well as claims 20-22 depending from it be allowed.

In addition, an amendment of claims 1 and 19 had been presented by Applicant in the response to the final Office Action for consideration by the Examiner in accordance with 37 CFR §1.116. This amendment adds the further limitation to each claim that removal of the bottom board from the interior of the body of the storage bin enables the bin to be collapsed by folding each second sidewall into the interior along the folding-seam and folding over the bottom. This limitation is also not taught by any of the references cited by the Examiner. (See further remarks in Response of 7/14/2005 at pages 12-13).

The proposed amendment was not entered by the Examiner in an Advisory Action mailed on July 26, 2005 on the basis that the limitation "folding over the bottom" in the amendment raises a new issue that requires further consideration and/or search and raises the issue of new matter. He denied reconsideration of the entry of the amendment in an Advisory Action mailed on September 1, 2005.


The proposed addition of the limitation in question is not new matter. Claim 19, as previously presented and pending, recites that "removal of the bottom board from the bottom enables the bin to be collapsed by folding the second sidewalls into the interior of the body." The folding over of the bottom seen in Fig. 3 of the present application is an inherent property of this novel bin in view of its ability to laterally collapse into a substantially flat configuration as

shown in Fig. 4. An application can be amended to recite a function or property that a device disclosed in the application inherently performs without it constituting the introduction of prohibited new matter, since the application necessarily discloses that function or property even though it may say nothing explicit about it. MPEP §2163.07. (See further remarks in Response to Advisory Action filed on August 15, 2005 at page 2).

This limitation also does not raise a new issue requiring further consideration and/or search. Collapsibility of the soft storage bin is not a new issue but was one originally claimed and described in this application. The addition limitation in question serves to simply clarify the manner by which "removing the bottom board from the interior enables the bin to be collapsed" as presently recited in pending claim 1. As such, the amendment required only cursory review by the Examiner.

Applicant submits that all rejections in the final Office Action of March 15, 2005 of each of the pending claims have been traversed by argument, placing the application in condition for allowance. In addition, Applicant believes that the refusal of the Examiner to enter the amendment was misplaced and that the amendment should have been admitted pursuant to 37 CFR §1.116. If entered, claims 1 and 19, as amended, further overcome each of their rejections by the Examiner under 35 U.S.C. §103(a) and, on this basis as well, these claims, as well as each of the claims that depend from them, should have been allowed.

Respectfully submitted,



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